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Paper No. 2

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

PATRICK O. BROWN and TIDHAR D. SHALON
(08/514,875),

Junior Party,

v.

MAILED

MAR 17 2003

PAT. & T.M. OFFICE
BOARD OF PATENT APPEALS
AND INTERFERENCES

STEPHEN P. A. FODOR, DENNIS W. SOLAS,
and WILLIAM J. DOWER
(5,800,992),

Senior Party.

Interference No. 104,358

Before SCHAFER, TORCZON, and LANE, Administrative Patent Judges.

LANE, Administrative Patent Judge.

JUDGMENT PURSUANT TO REMAND FROM UNITED STATES DISTRICT COURT

Brown has submitted a paper entitled "BROWN SUBMISSION OF DISTRICT COURT ORDERS FROM CIVIL ACTION UNDER 35 U.S.C. §146" (Paper 68). Attached to the paper

is said to be a true and correct copy of each of the following from the United States District Court for the Northern District of California in the case of *Incyte Pharmaceuticals, Inc. et. al. v. Affymetrix, Inc.*, Case No. C99-21111 JF:

- (1) an Order declaring Fodor's involved US Patent 5,800,992 ("992) invalid (Paper 65 at Exh. A), and
- (2) a Final Judgment remanding the matter to the Board of Patent Appeals and Interferences for further proceedings consistent with the Court's final judgment (Paper 65 at Exh. B).

According to the Order and Final Judgment, the Court "finds and concludes, and accordingly hereby declares" that all the claims (claims 1-5) of the '992 patent are invalid (Exh. A at 1-2) for lack of written description (claims 4 and 5) and for indefiniteness (claims 1-3) (Exh. B at ¶¶ 2 and 3). The Final Judgment states that there can be no interference between the claims of the '992 patent and the claims of Brown's 08/514,875 application since the '992 patent is invalid (Exh. B at ¶ 4).

The Court's statement that "there can be no interference" is ambiguous. If we construe the Court's statement as meaning that there is no interference-in-fact between the parties, then the Court's Order and Final Judgment would not result in a judgment that is adverse to the patentee, Fodor. See 35 USC § 135(a). Instead, we construe the complete Order and Final Judgment of the Court as intending that we enter judgment that is adverse to Fodor. Our action is consistent with the Court's Order and Final Judgment and with the law. See *Cabilly v. Boss*, 60 USPQ2d 1752, 1755 (BPAI 2001).

On 12 March 2003, Brown spoke with Board of Patent Appeals and Interferences paralegal Yolunda Townes and requested a conference call with the Administrative Patent Judge. In view of this Judgment, Brown's request is moot.

ORDER

Upon consideration of the record of the interference and for reasons given, it is

ORDERED that the Order of the Board of Patent Appeals and Interferences awarding judgment against Brown (Paper 60 at 11) is VACATED in view of the Order and Final Judgment of the United States District Court for the Northern District of California in the case of *Incyte Pharmaceuticals, Inc. et. al. v. Affymetrix, Inc.*, Case No. C99-21111 JF;

FURTHER ORDERED that, pursuant to the Order and Final Judgment of the United States District Court for the Northern District of California in the case of *Incyte Pharmaceuticals, Inc. et. al. v. Affymetrix, Inc.*, Case No. C99-21111 JF, judgment is awarded against STEPHEN P. A. FODOR, DENNIS W. SOLAS, and WILLIAM J. DOWER;

FURTHER ORDERED that STEPHEN P. A. FODOR, DENNIS W. SOLAS, and WILLIAM J. DOWER is not entitled to a patent containing claims 4 and 5 which correspond to count 1, the sole count in the interference; and

FURTHER ORDERED that a copy of this Judgment and a copy of the Order and Final Judgment of the District Court (Exh. A and Exh. B at Paper 65) each shall be given a paper number and shall be entered into the administrative records of Brown's 08/514,875 application and Fodor's 5,800,992 patent.

RICHARD E. SCHAFFER

RICHARD E. SCHAFER
Administrative Patent Judge

RICHARD TORCZON
Administrative Patent Ju

SALLY GARDNER LANE
Administrative Patent Judge

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cc (via facsimile and First Class Mail):

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